

REMARKS

The Office Action dated December 10, 2008 was received and carefully reviewed. By this response, claims 1-3, 5, 8, 10-12, and 16 are amended to clarify the invention, and not for reasons of patentability. Claims 5-7, 9, and 11-29 were withdrawn for being directed to a non-elected invention, by a previous reply. New claim 30 has been added by this reply, and does not include new matter. Accordingly, claims 1-30 are currently pending in the subject application.

Support for the amendments to claims 1-3 can be found at least in paragraphs [0075] and [0085] of the specification as originally filed. Further, support for amendments to claim 3 can be seen at least in paragraphs [0067]-[0071] of the specification as originally filed. Further, support for the features recited in newly added claim 30 can be seen at least in paragraph [0085] of the specification as originally filed. Thus, no new matter is included in the amendments to claims 1-3, or in newly added claim 30.

Reconsideration and allowance of the subject application is hereby requested in view of the above amendments and the following remarks.

Election/Restrictions

The Examiner acknowledges Applicants election of claims 1-4, 8 and 10 in the reply filed on 9/19/2008, but the Examiner purports that “[b]ecause applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse” (see the Office Action, e.g., page 2). However, Applicants’ response dated September 19, 2008 actually states:

In response to the Office Action dated August 19, 2008, Applicants hereby elect, with traverse, claims 1-4, 8 and 10, which read on Species A. Claims 5-7, 9 and 11-17 are withdrawn from consideration for being directed to a non-elected invention.

However, Applicants respectfully submit that independent claims 1-3 are generic with respect to Species A-D. Furthermore, claims 5-7 and 9 depend from independent claims 1-3, and further limit the scope of independent claims 1-3. Thus, Applicants respectfully request that claims 5-7 and 9 be rejoined and examined on the merits, or allowed when independent claims 1-3 are allowed.

Thus, Applicants election of claims 1-4, 8 and 10 was made explicitly with traverse in the reply dated September 19, 2008, for the reasons seen above. Accordingly, Applicants respectfully request that claims 5-7 and 9 be rejoined and examined on the merits, or allowed, upon allowance of independent claims 1-3, as was requested in the reply of September 19, 2008.

Claim Objections

Claim 2 has been amended to correct the typographical error, which states “the fight-absorbing material” to now recite “the light-absorbing material”. Accordingly, Applicants respectfully request the withdrawal of the objection to claim 2.

Claim Rejections - 35 U.S.C. § 112

Claim 10 stands rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not reasonably provide enablement for the recitation that “the first region has higher wettability than the second region with respect to the compound”. Applicants contend that the amendment to claim 10 obviates any perceived lack of enabling disclosure noted by the Examiner. Accordingly, Applicants respectfully request the withdrawal of this rejection.

Claims 3, 4, 8, and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants contend that the amendments to claims 3 and 8 obviate any perceive indefiniteness noted by the Examiner. Accordingly, Applicants respectfully request the withdrawal of this rejection.

Claim Rejections - 35 U.S.C. § 102 or § 103

Claims 1-4, 8, and 10 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Shirota et al. (U.S. Patent No. 6,399,257 B1) (*Shirota*, hereinafter). Applicants traverse this rejection for at least the reasons set forth below.

Applicants respectfully submit that present independent claims 1, 2, and 3, and the claims dependent therefrom, are patently distinguishable over *Shirota*, since *Shirota* fails to disclose, teach, or suggest all of the features recited in the pending claims. For example, independent

claim 1 (emphasis added) recites:

1. A method for forming a pattern comprising the steps of:
forming a wiring of a semiconductor device over a light-transmitting substrate;
forming a first region having a substance including a light-absorbing material over the light-transmitting substrate and the wiring;
forming a second region by irradiating the substance with light to modify a part of a surface of the substance wherein the light has a wavelength which is absorbable by the light-absorbing material; and
forming a conductive pattern on the second region by discharging a compound including a pattern forming material.

Further, independent claim 2 (emphasis added) recites:

2. A method for forming a pattern comprising the steps of:
forming a wiring of a semiconductor device over a light-transmitting substrate;
forming a first region having a substance including a light-absorbing material over the light-transmitting substrate and the wiring;
forming a second region by irradiating the substance with light through the light-transmitting substrate to modify a part of a surface of the substance wherein the light has a wavelength which is absorbable by the light-absorbing material; and
forming a conductive pattern on the second region by discharging a compound including a pattern forming material.

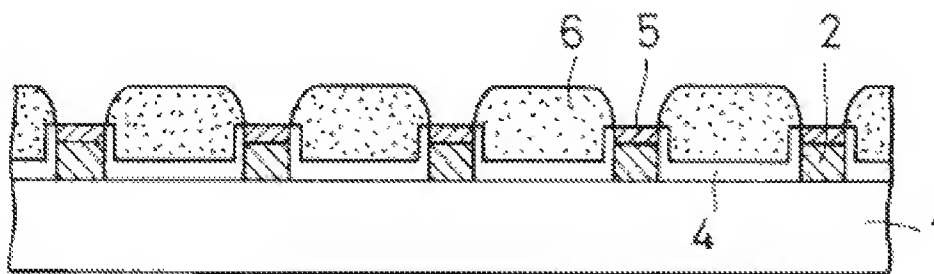
Furthermore, independent claim 3 (emphasis added) recites:

3. A method for forming a pattern comprising the steps of:
forming a wiring of a semiconductor device over a light-transmitting substrate;
forming a first region having a substance including a light-absorbing material over the light-transmitting substrate and the wiring;
forming a second region by irradiating the substance with a light through the light-transmitting substrate to modify a part of a surface of the substance wherein the light has a wavelength which is absorbable by the light-absorbing material;
removing the light-absorbing material; and

forming a conductive pattern on the second region by discharging a compound including a pattern forming material.

Thus, independent claims 1-3 are directed to, *inter alia*, the feature of forming a wiring of a semiconductor device over a light-transmitting substrate. Applicants contend that *Shirot*a neither discloses, teaches, nor suggests at least the feature of forming a wiring of a semiconductor device over a light-transmitting substrate, as recited in present independent claims 1-3.

By contrast to the present invention, *Shirot*a discloses a method of forming a color filter that prevents uncolored dots (see *Shirot*a, e.g., col. 5, lns. 25-28 and FIGS. 1A-1F). *Shirot*a teaches that this is accomplished by exposing a photosensitive layer 3 to light over an area wider than the opening of a light-shielding layer 2, thereby forming hydrophilic areas 4 (see *Shirot*a, e.g., col. 5, lns. 25-39 and FIGS. 1B-1C). Then, as seen in FIG. 1D below, a setting ink 6 is applied to the hydrophilic areas 4 using a predetermined coloring pattern, such as R, G, and B (see *Shirot*a, e.g., col. 6, lines 2-6 and FIG. 1D). Finally, the setting ink 6 is set with a treatment, such as heating or irradiation with light to form R, G, and B colored portions 7 (see *Shirot*a, e.g., col. 6, ln. 66 to col. 7, ln. 1). However, *Shirot*a is completely silent with regard to forming a wiring of a semiconductor device over a light-transmitting substrate, as recited in present independent claims 1-3.



For at least the reasons stated above, *Shirot*a neither anticipates nor renders obvious all of the features of the invention as presently claimed. Accordingly, Applicants respectfully request reconsideration and allowance of independent claims 1-3.

Further, claims 4, 8, and 10 are allowable at least by virtue of their dependency from one of the independent claims, but also because they are distinguishable over the prior art. Accordingly, Applicants respectfully request the withdrawal of the rejection, and the allowance of these claims.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. If, however, the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney/agent to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,
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Date: March 10, 2009

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